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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/925,486	08/10/2001	Shingo Eguchi	12732-067001	2842

26171 7590 04/17/2003

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EXAMINER
SEFER, AHMED N

ART UNIT	PAPER NUMBER
2826	

DATE MAILED: 04/17/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/925,486	EGUCHI ET AL.	
	Examiner	Art Unit	
	A. Sefer	2826	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____ .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) 1-27 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☒ Claim(s) 9-27 is/are allowed.

6)☒ Claim(s) 1-8 is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4 .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
> (e) the invention was described in-
> (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or
> (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

2. Claims 1 and 3 are rejected under 35 U.S.C. 102(b) as being anticipated by Mizobata et al. (JP 7-28089).

Mizobata et al disclose in fig. 4 a semiconductor device comprising: a first electrode 4; an insulating film 11 formed on said first electrode; a contact hole 7 which is provided in said insulating film and has a depth so as to reach said first electrode; a gate wiring 5 which is formed on said insulating film and connected with said first electrode through said contact hole; a second electrode 1 or a pixel electrode (as in claim 3) provided on said insulating film; and a liquid crystal layer 14 provided over said second electrode. wherein said second electrode is provided so as to block an electric field by said first electrode to said liquid crystal layer.

As to the said second electrode being provided so as to block an electric field by said first electrode to said liquid crystal layer recited in the claim, a recitation of an intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior

art structure is capable of performing the intended use, then it meets the claim. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

3. Claims 1-4 are rejected under 35 U.S.C. 102(e) as being anticipated by Shibata et al. US Patent No. 6,392,255.

Shibata et al disclose (see fig. 1 and abstract) a semiconductor device comprising: a first electrode 104; an insulating film 106 formed on said first electrode; a contact hole (unnumbered) which is provided in said insulating film and has a depth so as to reach said first electrode; a gate wiring 107 which is formed on said insulating film and connected with said first electrode through said contact hole; a second electrode provided 110/115 or a pixel electrode (as in claim 3) on said insulating film; and a liquid crystal layer 116 provided over said second electrode, wherein said second electrode is provided so as to block an electric field by said first electrode to said liquid crystal layer.

As to claim 2, Shibata et al disclose a pixel electrode 115 formed on said insulating film and said second electrode is in contact with said pixel electrode.

As to claim 4, Shibata et al disclose in fig. 7 a semiconductor device incorporated into an electronic equipment selected from the group consisting of a personal computer, a video camera, a mobile computer, a goggle type display, a player, a digital camera.

4. Claims 5-8 are rejected under 35 U.S.C. 102(e) as being anticipated by Shibata et al. US Patent No. 6,392,255.

Shibata et al disclose (see fig. 1 and abstract) a semiconductor device comprising: a semiconductor film 102, a gate insulating film 103 formed on said semiconductor film; a first electrode 104 on said gate insulating film and overlaps said semiconductor film; an insulating

film 106 formed on said first electrode; a contact hole (unnumbered) which is provided in said insulating film and has a depth so as to reach said first electrode; a gate wiring 107 which is formed on said insulating film and connected with said first electrode through said contact hole; a second electrode provided 110/115 or a pixel electrode (as in claim 7) on said insulating film; and a liquid crystal layer 116 provided over said second electrode, wherein said second electrode is provided so as to block an electric field by said first electrode to said liquid crystal layer.

As to claim 6, Shibata et al disclose a pixel electrode 115 formed on said insulating film and said second electrode is in contact with said pixel electrode.

As to claim 8, Shibata et al disclose in fig. 7 a semiconductor device incorporated into an electronic equipment selected from the group consisting of a personal computer, a video camera, a mobile computer, a goggle type display, a player, a digital camera.

Allowable Subject Matter

5. Claims 9-27 are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to A. Sefer whose telephone number is (703) 605-1227.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nathan Flynn can be reached on (703) 308-6601.

ANS
April 14, 2003

NATHAN J. FLYNN
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2800